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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/914,492 | 11/14/2001 | Teresa Barbara Crook | CM2045F | 8062 |

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,492

Applicant(s)

CROOK ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of Amendment filed on November 4, 2002. Claims 1-17 are pending. Claim rejection under 35 U.S.C. § 112, first paragraph is withdrawn in view of further consideration. Claim rejection under 35 U.S.C. § 112, second paragraph is withdrawn in view of the claim amendment by applicants. Claim rejections under 35 U.S.C. § 103 are maintained in part, and modified to meet the new claim limitation in part.

Claim Rejections - 35 USC § 103

1. Claims 1-3 and 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura et al. (US 5690916) ("Kimura") and Dietz et al. (US 6132873) ("Dietz") and JP 57098205 A ("Pola abstract").

The rejection is maintained as indicated on the previous Office action dated July 5, 2002.

2. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura, Dietz, and Pola abstract, as applied to claims 1-3 and 9-17 above, and further in view of Nishimura et al. (JP 410194944 A, English abstract of JP 10194944 A) ("Nishimura"), Mizugushi et al. (US 5520917) ("Mizugushi") and Mathur (US 4096240).

Kimura and Dietz, discussed above, fail to teach the anatase type titanium dioxide and the skin condition actives recited in the instant claims.

Nishimura teaches using anatase type titanium dioxide as an ultraviolet light-protecting agent in cosmetics. See abstract. The reference fails to teach silicone-coated anatase type titanium dioxide. ✓

Mizugushi teaches the process of coating anatase type titanium dioxide with silica. See Example 3. The reference teaches that the coated particles disclosed in the patent are useful in cosmetic applications. See col. 9, line 44 – col. 10, line 61. The advantages of using the silicone-coated particles include UV protection effects, smooth spreadability, and hiding effects. See col. 10, lines 51 – 61. Makeup compositions comprising the Mizugushi particles are said to render natural and beautifying effects over prolonged time. See *Id.* ✓

Mathur teaches skin lightening composition comprising niacinamide. See abstract. The reference suggests employing from about 0.1-10 % of the active. See col. 1, line 66 – col. 2, line 30. ✓

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding or substituting the matting agent therein with silicone-coated anatase titanium dioxide, as motivated by Nishimura and Mizugushi, because of the expectation of successfully producing a composition with enhanced UV protection. The skilled artisan would have been further motivated to add niacinamide as suggested by Mathur because of the expectation of successfully producing a skin-color adjusting cosmetic composition with skin-lightening effect.

All components in the instant invention are well known. Nothing nonobvious or unexpected is seen in combining the conventional ingredients well known in cosmetic art. See MPEP 716.02.

Response to Arguments

Applicant's arguments filed on November 4, 2002 have been fully considered but they are not persuasive in part, and are moot in part view of the new ground of rejection.

Applicants argue that the exhaustive list of possible ingredients in column 9 in the Kimura reference does not provide motivation to select specific components of the instant claims. Examiner notes however that the rejection is not based on the disclosure on column 9, but the specific formulation example 8.

The rejection also set forth that so long as the prior art teaches the general conditions of the claimed invention, the differences in concentration would not render patentability unless criticality is shown. See MPEP § 2144.05. In this case, the Kimura invention is directed to adjusting skin color using coated titanium oxide. Although applicants assert that the amount of the pigments were determined for a particular visible effect, examiner reiterates that such is the motivating force that would have led a skilled artisan to find optimum weight range by routine experimentations.

In response to applicants' assertion that the Kimura's globular nylon particles are larger and produce a grainy product, examiner notes that such evidence should be factually supported by appropriate affidavit or declaration by applicants. See MPEP § 716.02 (c). Nevertheless, the motivation to employ porous nylon particles is found in the Pola abstract, as indicated in the previous Office action.

Applicants further argue that Kimura and Dietz as combined fail to teach using porous nylon particles, and that there is no teaching of the amount which the Pola porous nylon particles should be used in cosmetic formulation. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the issue is whether, given the objective teachings of the references, it would have been obvious to a skilled artisan to substitute the nylon particles in Kimura with the porous nylon particles in Pola abstract. In view of the combined references, the skilled artisan would have found it obvious to use the Pola nylon particles within the similar weight range that the globular particles are used in the Kimura formulation.

While there is no explicit disclosure in the Polar reference regarding the refractive index of the particles, examiner reiterates that those prior art porous spherical nylon particles meet the particle size of the instant claims, and are known as useful in cosmetic formulations. These evidences support the examiner's presumption that the Polar nylon particles are same as or substantially similar to the applicants' ingredient. The fact that the reference is silent as to a particular characteristic of the porous nylon particles does not render the use of the conventional cosmetic ingredient for the same purposes novel or nonobvious.

Applicants' argument in reference to the obviousness rejection over Kimura, Dietz, and Pola abstract, and further in view of Nishimura and Mathur is moot in view of the new ground of rejection.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
January 15, 2003



SREENI PADMANABHAN
PRIMARY EXAMINER

1/27/03